

REMARKS

Claims 1-20 remain pending and at issue in the present application. Reconsideration and allowance of all pending claims are respectfully requested.

The Office rejects claims 1-20 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. More specifically, the Examiner alleges that the term “rigidly coupled” fails to comply with the written description requirement of 35 U.S.C. §112 because “there is no mention of a rigid or nonflexible connection” in the specification. Despite the Examiner’s continued resistance to apply the appropriate standard for the written description requirement, applicant has amended the claims to remove the allegedly offending language in an effort to advance prosecution of this application. Because new language has been added to the independent claims, however, applicant sincerely encourages the Examiner to adopt and apply the appropriate standard for evaluating compliance with the written description requirement, as discussed more fully below.

Applicant reminds the Examiner that the written description requirement does not require literal, or word-for-word, support in the specification for the subject matter of the claims. (See generally M.P.E.P. § 2163.02). Instead, the proper standard for determining compliance with the written description requirement is whether the description conveys to one of ordinary skill, with reasonable clarity, that the applicant possessed the invention at the time the application was filed. (See M.P.E.P. § 2163.02, page 2100-179 of the Eighth Edition, Revision 5). The “original description” provided by an application includes the “words, structures, figures, diagrams, and formulas.” *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). In addition to explicit support, the disclosure may provide implicit or inherent support for a claim limitation. (See M.P.E.P. § 2163, page 2100-177 of the Eighth Edition, Revision 5). For example, the Federal Circuit has held that an original specification for a method of forming images which describes removal of microcapsules from a surface unequivocally teaches the absence of permanently fixed microcapsules, and therefore supports amended claim language requiring that microcapsules be “not permanently fixed” to the underlying surface, even though the original disclosure did not explicitly recite the “not permanently fixed” language. *In re Wright*, 866 F.2d 422, 425, 9 USPQ2d 1649, 1651 (Fed. Cir. 1989).

Accordingly, a proper written description analysis looks to not only the written words of the specification but also the drawings, and to anything that may be implicitly or inherently disclosed, to determine whether the application reasonably conveys to one of skill in the art that the inventor had possession of the claimed subject matter.

Under the appropriate standard articulated above, the subject matter currently added to claims 1-20 complies with the written description requirement of 35 U.S.C. § 112, first paragraph. Each independent claim has been amended in four areas. First, the outer shaft distal end is now said to be positioned distal, rather than proximate, to the inner shaft distal end. This amendment corrects an obvious error in the claims, as the outer shaft distal end is clearly shown as being positioned distal to the inner shaft distal end in Figs. 9-11.

Second, each independent claim now recites that the inner shaft distal end is configured to engage the outer shaft distal end. Support for this subject matter is found on page 5 of the specification, which describes the outer shaft distal end as having a frusto-conical section 38 and the inner shaft distal end as having a frusto-conical section 60. The section 60 is clearly shown as engaging the section 38 in Fig. 11, and therefore the original disclosure clearly shows an inner shaft distal end that is configured to engage the outer shaft distal end as now claimed.

Third, each independent claim is amended to recite an outer shaft first position in which the inner shaft distal end is spaced from the outer shaft distal end and a second position in which the inner shaft distal end engages the outer shaft distal end. The first position is illustrated in Fig. 10, while the second position is illustrated in Fig. 11.

Finally, the claims as amended now recite a catheter coupled to and extending distally from the rigid inner member distal end. The catheter is described in the second paragraph of page 7 of the specification as being "attached to and extending away from the distal end 70 of the rigid inner member 20." This catheter 100 is also illustrated in Figs. 9-11 as originally filed.

In view of the foregoing, adequate support for each amended claim element is identified that conveys, with reasonable clarity, to one of ordinary skill in the art the subject matter now claimed, and therefore consideration and entry of these amendments are respectfully requested.

Turning to the rejections based on the prior art, the Office has rejected claims 1-20 under 35 U.S.C. §103(a) as allegedly obvious over U.S. Patent No. 5,634,928 ("Fischell") in view of U.S. Patent No. 5,026,377 ("Burton"). Applicant traverses this ground of rejection.

The proposed combination of prior art fails to disclose or suggest each element of the claims. More specifically, the cited art fails to disclose or suggest at least: (1) an inner shaft having a distal end configured to engage an outer shaft distal end; (2) an outer shaft second position in which the inner shaft distal end engages the outer shaft distal end; and (3) a catheter coupled to and extending distally from the rigid inner member distal end.

The Examiner equates Fischell's pusher tube 24 and outer tube 13 to the claimed outer shaft and inner shaft, respectively. As clearly seen from Fig. 1, a distal end of the outer tube 13 is encased in a balloon 16, and therefore cannot engage the pusher tube 24. Accordingly, Fischell fails to disclose or suggest an inner shaft having a distal end configured to engage an outer shaft distal end, or an outer shaft second position in which the inner shaft distal end engages the outer shaft distal end as now specified in the claims. Additionally, the Examiner equates Fischell's inner tube 11 to the claimed inner member. Fischell does not disclose any structure that is coupled to and extends distally from the inner tube 11, and therefore fails to disclose or suggest the catheter as now claimed.

Burton fails to supply the deficiencies in Fischell noted above. Instead, Burton discloses a grip member 9 coupled to a hollow core 5 that slides within an outer sleeve 1. A stent 10 is interposed between the grip member 9 and a distal end of the outer sleeve 1. Consequently, Burton fails to disclose or suggest an inner shaft having a distal end configured to engage an outer shaft distal end, or an outer shaft second position in which the inner shaft distal end engages the outer shaft distal end as now specified in the claims. Burton further fails to disclose or suggest a catheter that is coupled to and extends distally from the hollow core 5, and therefore fails to disclose or suggest the catheter as now claimed.

In view of the foregoing, the proposed combination of Fischell and Burton fails to disclose or suggest each element of the claims at issue. Consequently, the prior art rejection asserted against the claims must be withdrawn.

Additionally, the cited prior art fails to teach or suggest the relationship between the inner and outer shafts as recited in the pending independent claims. Each independent claim requires the outer shaft to have distal end that is disposed distally to the distal end of the inner shaft. Each claim further recites that the outer shaft has a first position, in which the distal end of the inner shaft is spaced from the distal end of the outer shaft, and a second position, in which the distal end of the inner shaft engages the distal end of the outer shaft. In both positions, however, the outer shaft distal end is disposed distally to the distal end of the outer shaft.

The cited prior art does not teach this positional relationship between the inner and outer shafts. The inner tube 13 of Fischell has a distal end that is *always* disposed distally with respect to the distal end of the tube 24. See Fig. 1 of Fischell. Furthermore, Burton does not disclose both an inner and outer tube, and therefore fails to disclose the above-noted relationship therebetween. Thus, for at least this additional reason, the obviousness rejection based on the proposed combination of Fischell and Burton must be withdrawn.

CONCLUSION

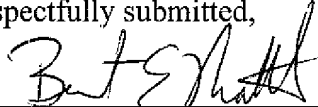
It is submitted that the present application is in good and proper form for allowance. A favorable action on the part of the Examiner is respectfully solicited.

If, in the opinion of the Examiner a telephone conference would expedite prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

The Patent Office is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-3629.

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Respectfully submitted,

By 

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